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OFFICE OF PETITIONS

In re Patent of Jeyhan Karaoguz et al.	:	DECISION ON REQUEST
Patent No. 7,958,525	:	FOR RECONSIDERATION OF
Issue Date: June 7, 2011	:	PATENT TERM ADJUSTMENT
Application No. 10/675,466	:	AND NOTICE OF INTENT TO
Filing Date: September 30, 2003	:	ISSUE CERTIFICATE OF
Attorney Docket No. 15038US02	:	CORRECTION

This is a decision on the petition filed August 8, 2011, which is being treated as a petition under 37 C.F.R. § 1.705(d) requesting the patent term adjustment indicated on the patent be corrected to indicate the term of the patent is extended or adjusted by one thousand three hundred twenty-one (1,321) days.

The first page of the petition asserts Patentees submitted "an earlier request for recalculation under 37 CFR § 1.705(b)." However, Office records fail to indicate the Office received such a request. The instant decision is based solely on the petition filed August 8, 2011.

The petition to correct the patent term adjustment indicated on the patent to indicate the term of the patent is extended or adjusted by one thousand three hundred twenty-one (1,321) days is **GRANTED to the extent indicated herein.**

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 C.F.R. § 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 C.F.R. § 1.136.

No portion of this decision should be construed as a waiver of the requirement, set forth in 35 U.S.C. § 154(b)(4), that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. § 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The application matured into Patent No. 7,958,525 on June 7, 2011. The patent sets forth a patent term adjustment determination of 1,286 days. The instant petition and the required fee under 37 C.F.R. § 1.18(e) were timely filed August 8, 2011.

The petition argues the correct period of delay under 35 U.S.C. § 154(b)(1)(B) (“B Delay”) is 636 days, not 635 days as calculated by the Office.

The petition argues the Office’s entry of a 1-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b) based on the submission of the issue fee on May 2, 2011, was improper.

The petition argues the correct period of delay under 37 C.F.R. § 1.704(c)(10) is 18 days, not 51 days.

The petition argues the correct patent term adjustment is 1,321 days, not 1,286 days.

Issue 1

The petition argues the correct period of B Delay is 636 days, not 635 days, based on an assertion the Office improperly excluded the date a request for continued examination (“RCE”) was filed from the period of B Delay

Pursuant to 35 U.S.C. § 154(b)(1)(B), the period of B Delay does not include “any time consumed by continued examination of the application requested by the applicant.”

37 C.F.R. § 1.703(b) states the period of B Delay does not include:

The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

The petition fails to demonstrate 37 C.F.R. § 1.703(b) is inconsistent with the statute.

Pursuant to 37 C.F.R. § 1.703(b), the number of days excluded from the period of B Delay when a RCE is filed includes the date the RCE is filed. Therefore, the Office correctly excluded the date the RCE was filed from the period of B Delay.

The petition expresses a belief the Office does not count the date a Notice of Appeal is filed when determining the number of days to be excluded from B Delay as time consumed by appellate review. The petition asserts the manner in which the Office calculates the number of days consumed by appellate review supports a conclusion the number of days consumed by continued examination should not include the date a RCE is filed.

The Office currently counts the date a Notice of Appeal is filed as part of the number of days consumed by appellate review. Therefore, the manner in which the Office calculates the number of days consumed by appellate review is not inconsistent with the manner in which the Office calculates the time consumed by continued examination.

Issue 2

The issue fee was paid on May 2, 2011, which was three months and one day after the Office mailed the Notice of Allowance. As a result of the submission of the issue fee on May 2, 2011, the Office entered a 1-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b). The petition argues the submission of the issue fee on May 2, 2011, should not have resulted in a reduction in patent term adjustment.

The date three months from the issue date of the Notice of Allowance was May 1, 2011, which was a Sunday. The issue fee was paid on Monday, April 25, 2011. As a result of 35 U.S.C. § 21(b), when the three-month deadline to reply to an Office action falls on a weekend or holiday, and a response is filed on the next business day, a reduction in patent term adjustment under 37 C.F.R. § 1.704(b) is inappropriate. Therefore, the Office's entry of a one-day reduction in patent term adjustment as a result of the submission of the issue fee on May 2, 2011, was improper.

Issue 3

The petition argues the correct total period of delay under 37 C.F.R. § 1.704(c)(10) is 18 days, not 51 days.

Relevant Facts for Issue 3

The Office mailed a Notice of Allowance on February 1, 2011.

An "Amendment Under 37 C.F.R. § 1.312" ("Amendment 1") was filed April 18, 2011. The amendment made changes to claims 1 and 36.

An "Amendment After Allowance Under 37 C.F.R. § 1.312" ("Amendment 2") was filed April 29, 2011. The amendment changed drawing figures 3-11 to correct informalities. The amendment was accompanied by a copy of ten replacement sheets of drawings. The copy of the Electronic Filing Acknowledgment Receipt corresponding to Amendment 2 indicates the amendment was filed at 5:25 p.m.

The Office's PALM system includes the following entry dated April 29, 2011: "Workflow – Drawings Finished." The petition assumes the entry is an indication the Office finished all processing of the drawings on April 29, 2011, the same date the drawings were filed.

The Office's PALM system includes the following entry dated May 4, 2011: "Application is Considered Ready for Issue." The petition asserts the entry indicates "no further delay occurred after that date."

The Office mailed a "Response to Rule 312 Communication" responding to Amendment 1, but not Amendment 2, on May 6, 2011.

When calculating patent term adjustment, the Office entered a total reduction of 51 days in patent term adjustment under 37 C.F.R. § 1.704(c)(10).

Discussion of Issue 3

37 C.F.R. § 1.704(c)(10) states,

[Upon] [s]ubmission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed ... the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
- (ii) Four months.

The number of days beginning April 18, 2011, the date Amendment 1 was filed, and ending May 6, 2011, the date the Office responded to Amendment 1, is 19 days. Therefore, the period of delay under 37 C.F.R. § 1.704(c)(10) based on the submission of Amendment 1 is 19 days.

The number of days beginning April 29, 2011, the date Amendment 2 was filed, and ending June 7, 2011, the date the patent issued, is 40 days. Therefore, the period of delay under 37 C.F.R. § 1.704(c)(10) based on the submission of Amendment 2 is 40 days.

The 19-day period of delay based on the submission of Amendment 1 and the 40-day period of delay based on the submission of Amendment 2, overlap by 8 days. Therefore, a total reduction in patent term adjustment of 51 ($19 + 40 - 8$) days is warranted under 37 C.F.R. § 1.704(c)(10).

The petition argues the correct period of delay under 37 C.F.R. § 1.704(c)(10) based on the submission of Amendment 1 is 18 days, not 19 days. Specifically, the petition asserts the method used to calculate the period of reduction set forth in 37 C.F.R. § 1.704(c)(10) is inconsistent with 35 U.S.C. § 154. Although the arguments in the petition have been considered, the arguments are insufficient to establish the method used to calculate the period of reduction set forth in 37 C.F.R. § 1.704(c)(10) is inconsistent with the provisions of 35 U.S.C. § 154.

The petition argues the submission of Amendment 2 should not have resulted in an additional reduction in patent term adjustment. Since the time period beginning April 29, 2011, the date Amendment 2 was filed, and ending May 6, 2011, the date the Office mailed a response to Amendment 2, overlaps with the previously discussed 19-day period of delay based on Amendment 1, the Office only needs to determine if the submission of Amendment 2 warrants entry of a reduction in patent term adjustment for any period of delay after May 6, 2011.

The petition argues a reduction in patent term adjustment based on the submission of Amendment 2 is unwarranted because the submission of the drawings did not result in any actual delay in the issuance of the patent. The petition also argues, even if Amendment 2 did result in

any actual delay, such actual delay did not include any of the time period after May 6, 2011. The provisions of 37 C.F.R. § 1.704(c)(10) do not limit any reduction in patent term adjustment to the actual delay resulting from the submission of a paper after allowance and the petition has not demonstrated the provisions of 37 C.F.R. § 1.704(c)(10) are inconsistent with the provisions of 35 U.S.C. § 1.154. Therefore, the Office is not persuaded the Office must base any reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(10) on the actual delay resulting from the submission of a paper.

The petition argues a reduction in patent term adjustment based on the submission of Amendment 2 is unwarranted because the Office never mailed a response to Amendment 2. The petition states, "The USPTO never mailed a response to [Amendment 2] as the rule clearly contemplates must occur for it to determine the length of the alleged delay for that filing."

37 C.F.R. § 1.704(c)(10) states the period of reduction under the regulation is the lesser of four months or, with emphasis added,

The number of days, *if any*, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper[.]

The language "if any" in the regulation can include a situation where an Office action or notice is never issued in response to a paper filed after allowance.

In this case, the period of delay under 37 C.F.R. § 1.704(c)(10) is four months unless the record demonstrates an "Office action or notice in response" to Amendment 2 was issued within four months of the date Amendment 2 was filed. The Office has determined the issuance of a patent constitutes "an Office action or response" to a paper, absent the issuance of an Office action or response, when applying 37 C.F.R. § 1.704(c)(10). The number of days beginning April 29, 2011, the date Amendment 2 was filed, and ending June 7, 2011, the date the patent issued, is 40 days. The period of time of 40 days is less than four months. Therefore, the period of delay under 37 C.F.R. § 1.704(c)(10) based on the submission of Amendment 2 is 40 days.

In view of the prior discussion, the record fails to prove the Office's entry of a total reduction of 51 days in patent term adjustment under 37 C.F.R. § 1.704(c)(10) was improper.

Conclusion

The petition has not established the Office miscalculated the period of B Delay or the total period of delay under 37 C.F.R. § 1.704(c)(10). However, the petition has established the Office improperly entered a 1-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b) based on the submission of the issue fee on May 2, 2011. Therefore, the correct patent term adjustment is 1,287 days, rather than 1,286 days as previously calculated by the Office.

The instant case is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the patent is extended or adjusted by **one thousand two hundred eight seven (1,287)** days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read 'C. Brantley', is positioned above the printed name.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION**

PATENT NO. : 7,958,525 B2
APPLICATION NO. : 10/675,466
DATED : June 7, 2011
INVENTOR(S) : Jeyhan Karaoguz et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the Title page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 1286 days.

Delete the phrase "by 1286 days" and insert -- by 1287 days--